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EXAMINER

VO, TED T

ART UNIT	PAPER NUMBER
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2191

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/975,681	HALEY ET AL.	
	Examiner	Art Unit	
	Ted T. Vo	2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Appeal brief, 4/13/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief filed on 04/13/2006 filed in response to the non-final office action dated on 10/07/05, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested,

1204.01 [R-3] > Reinstatement of Appeal

If an appellant wishes to reinstate an appeal after prosecution is reopened, appellant must file a **new notice of appeal** in compliance with 37 CFR 41.31 and a complete new appeal brief in compliance with 37 CFR 41.37. Any previously paid appeal fees set forth in 37 CFR 41.20 for filing a notice of appeal, filing an appeal brief, and requesting an oral hearing (if applicable) will be applied to the new appeal on the same application as long as a final Board decision has not been made on the prior appeal. If, however, the appeal fees have increased since they were previously paid, then appellant must pay the difference between the current fee(s) and the amount previously paid. Appellant must file a complete new appeal brief in compliance with the format and content requirements of 37 CFR 41.37(c) within two months from the date of filing the new notice of appeal. See MPEP § 1205.<

Response to Arguments

2. Double patenting is dropped because of filing terminal disclaimer.

The allowable subject of claims 13 and 16 is withdrawn.

Applicants' arguments in the brief have been fully considered.

Applicants' arguments are moot. New ground of rejection is set forth in this Office Action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4-6, 8-15, 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by the

Microsoft Access 2000, (hereinafter: Access 2000) provided by University of Southern California

(hereinafter: USC), "Access 2000 Advance Queries",

(http://www.marshall.usc.edu/computing/PDF_Files/Access/Access2000-Adv_Queries.pdf, 3-2000), and

provided by University of Illinois at Springfield (hereinafter: UIS), "Intermediate Access II"

(<http://www.uis.edu/ctl/training/handouts/intaccess2.pdf>, 3-2000).

2131.01 Multiple Reference 35 U.S.C. 102 Rejections

Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:

(A) Prove the primary reference contains an "enabled disclosure; "

(B) Explain the meaning of a term used in the primary reference; or

(C) Show that a characteristic not disclosed in the reference is inherent.

(See paragraphs I-III in 2131.01 for more explanation of each circumstance).

It should be noted that Microsoft Expression builder is known before 2000.

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per Claim 1: Access2000 including its Expression Builder (EB) discloses, *A system for providing a*

user interface display image support user entry of an expression (that is, the Access 2000 with the EB as

seen in by USC, p. 21), *comprising:*

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user interface menu generator for providing a displayable image (i.e. the EB. See USC, p. 20-23: all items 1-48, that tutor a user for using an EB) ***including***

a first image window listing a plurality of data items (USC, p. 21: in the EB having the window that shows data items Query1, Constants, Operators, etc), ***individually selectable from a plurality of different types of predetermined data items*** (This window provides a user individually selects a plurality of different types (i.e. subdirectory of Query1) of predetermined data items (i.e. Query1)) ***available for incorporation in an expression used for calculating a result value*** (USC, p. 21: The window shown with "Construct your equation here"),

an image prompt element for permitting user entry of said expression and for incorporating a data item in an entered expression from said listed data items to provide a resultant expression (USC, p. 21: The window shown with "Construct your equation here") ***used for calculating a result value in response to user selection of said data item in said first image window*** (USC, p. 20-23: all items 1-48, for seeing how such a response from a selection of data items); ***and***

an icon for initiating storing of said resultant expression (See the Icon "OK" in the EB); ***and an expression processor for processing said resultant expression to provide a calculated result value in response to user command*** (That is the DLLs provided within the Microsoft Windows supporting Access 2000 for running this application).

As per Claim 2: Access2000 including its Expression Builder (EB) discloses, ***"A system according to claim 1, wherein***

said plurality of different types of predetermined data items comprise predetermined data items and associated predetermined allowable values for corresponding predetermined data item (see the three lower windows within the EB. For example, see USC, p. 21 using the IFF, and see p. 15 that show the IFF using different types of predetermined data items comprise predetermined data items associated with predetermined allowable values or ranges used in the expression of the IFF. Another example, See UIS, p.8, the Expression Builder using an Absolute Function in the item Built-in Functions) ***and***

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said data item is incorporated in said expression together with an operator comprising at least one of, (a) a logical operator (See USC, the EB in p. 21, And, Or, Not) and (b) an algebraic operator to provide resultant expression (See USC, the EB in p. 21, +, -, / *).

As per Claim 4: Access2000 including its Expression Builder (EB) discloses, *A system according to claim 1, wherein predetermined data items are individually selectable by selection of displayed elements in a hierarchy tree structure, said displayed elements representing predetermined data items (USC, See the first window in the EB, that is a standard hierarchy tree structure. Another example, see UIS, p.8, the hierarchy tree structure of Functions and Built-in Functions).*

As per Claim 5: Access2000 including its Expression Builder (EB) discloses,

"A system according to claim 1, wherein said expression processor initiates generation of a displayed notification to a user indicating said entered expression is invalid and said expression processor initiates generation of a display notification to a user indicating said enter expression is invalid (Note: initiates generation of a displayed notification is part of Microsoft window, For example, in USC, see p. 26-27 the popup "Microsoft Access" that is responsive to running a query. See UIS, p.3, it has means for popping a dialog box when data is entered in correctly (referring to item 10, p.3). In p. 8, the Validation Rule is in the Properties section).

As per Claim 6: Access2000 including its Expression Builder (EB) discloses,

"A system according to claim 1, wherein said displayable image includes an icon for initiating verification an entered expression is valid; and said verification includes a syntax check of said enter calculable expression (See UIS, p. 8, the Validation Rule is in the Properties section of the EB).

As per Claim 8: Access2000 including its Expression Builder (EB) discloses,

"A system according to claim 1, wherein said plurality of different types of predetermined data items include miscellaneous values comprising predetermined specific words (Referring terms shown in Fields or Table).

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As per Claim 9: Access2000 including its Expression Builder (EB) discloses,

"A system according to claim 1, wherein displayable image includes an image prompt element supporting user entry of a name for identifying a resulting expression and said user interface menu generator provides an image window permitting user selection of a template calculable expression from a plurality of predetermined template expressions." (See all the Figures associated with the EB).

As per Claim 10: Access2000 including its Expression Builder (EB) discloses, *"A system according to claim 1, wherein said user interface menu generator provides an image window permitting user selection of a template calculable expression from a plurality of predetermined template calculable expression and said image prompt element incorporates a selected template calculable expression in response to user selection of said selected template calculable expression." (Built-in Functions showing template calculable expression in the far right window of the EB).*

As per Claim 11: Access2000 including its Expression Builder (EB) discloses, *"A system according to claim 1, wherein said first image window lists a plurality of selectable data items in a hierarchical tree type structure." (See in the EB, the data items appeared under a standard hierarchy structure. When click on a data item, it prompts a list of selectable data items).*

As per Claim 12: In the context of the specification FIG. 3, 314, 318, 324, 326, Access2000 including its Expression Builder (EB) discloses, *"A system according to claim 1, wherein said icon for initiating storing of said resulting expression initiates allocation of a version identifier to said resulting expression" (See UIS, the discussion of updating query where the query presents a resulting expression and this resulting expression requires an update/change. See text discussed in p. 3).*

As per Claim 13: Access2000 including its Expression Builder (EB) discloses, ***"A system for providing a user interface display image supporting user entry of an expression, comprising:
a user interface menu generator for providing a displayable image including,
a first image window listing a plurality of selectable data items individually selectable from a plurality of different types of predetermined data items available for incorporation in an expression used for calculating a result value,***

***an image prompt element for permitting user entry of said expression and for incorporating a data item in an entered expression from said listed data items to provide a resultant expression used for calculating a result value in response to user selection of said data item in said first image window, and
an icon for initiating storing of said resultant expression; and
an expression processor for resolving said resultant expression to provide a calculated result value in response to user command,***

(The above claimed limitation has its functionality corresponding to the limitation recited in Claim 1. See rationale addressed in Claim 10),

wherein said icon for initiating storing of said resultant expression initiates allocation of a version identifier to said resultant expression and said expression processor uses said version identifier in processing a latest version of said resultant expression to provide said calculated result value.

(The above claimed limitation has its functionality corresponding to the further limitation of Claim 1 - that is Claim 12. See rationale addressed in Claim 12).

***As per Claim 14:* Access2000 including its Expression Builder (EB) discloses, "A system for providing a user interface display image supporting user entry of an expression for use in deriving information associated with a patient, comprising:**

***a user interface menu generator for providing a displayable image including,
a first image window listing a plurality of selectable data items individually selectable from a plurality of different types of predetermined data items available for incorporation in an expression, said plurality of different types of predetermined data items comprise predetermined data items and associated predetermined allowable values for corresponding predetermined data item,***

***an image prompt element permitting user entry of said expression and for incorporating a data item in said expression from said listed data items to provide a resultant expression in response to user selection of said data item in said first image window, and
an icon for initiating storing of said resultant expression; and***

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an expression processor for resolving said resultant expression to provide a result in response to user command

(The above claimed limitation has its functionality corresponding to the limitation recited in Claim 1. See rationale addressed in Claim 1).

As per Claim 15: Access2000 including its Expression Builder (EB) discloses, ***a calculable expression*** (See USC, p. 21, the EB, "construct your equations here". A user who are prompted by this window can enter a simple ***calculable expression***) ***and said expression processor processes said resultant expression to provide a calculated result value in response to said user command*** (That is the DLLs provided within the Microsoft Windows supporting Access 2000 for running the expression entered by the user).

As per Claim 17:

Claim recites the limitations that perform the functionality corresponding to the functionality as recited by limitations of Claim 1. See rationale addressed in Claim 1 above.

As per Claim 18: Nielsen further discusses, "A system according to claim 17, wherein said expression processor processes said resultant expression to determine said resultant expression is valid and wherein said system for providing a user interface display image comprises machine executable code stored on a tangible storage medium." (See page 2, line 22, "query syntax", and see Figure 9, and further see page 4, lines 42-55, "an applet to compute the proper search syntax", "CONTENT HANDLER", see "Java Interpreter" in page 5, line 10, see "specifying the correct search syntax" in page 5, line 30, all these have means of handling *invalid expression*).

As per Claim 19: Access2000 including its Expression Builder (EB) discloses, ***A method for providing a user interface display image supporting user entry of an expression, comprising the activities of: initiating display of an image*** (See the EB, e.g. p. 21)

including,

(The below limitations is an intended use. It is a mere EB that is displayed by the above step).

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a first image window listing a plurality of selectable data items individually selectable from a plurality of different types of predetermined data items available for incorporation in an expression used for calculating a result value,

an image prompt element for permitting user entry of said expression and for incorporating a data item in an entered expression from said listed data items to provide a resultant expression used for calculating a result value in response to user selection of said data item in said first image window, and

an icon for initiating verification of said resultant expression to determine said resultant expression is valid (in the Microsoft Access 2000, the it provides an icon, a user click on it will prompt a properties section comprising Validation rule. See UIS, p. 8, the Validation Rule is in the Properties section of the EB), ***and***

an icon for initiating storing of said resultant expression; and
verifying said resulting expression is valid in response to a user selection of said icon for initiating verification (user simply clicks on an icon that prompts a properties section comprising Validation rule. Using this validation).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 7, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Microsoft Access 2000, (hereinafter: Access 2000) provided by University of Southern California (hereinafter: USC), "Access 2000 Advance Queries", and provided by University of Illinois at Springfield (hereinafter: UIS),

As per Claim 3: Access2000 including its Expression Builder (EB) discloses,

plurality of different types of predetermined data items such as (See USC, p. 21 the field includes data items such Company name, Country, etc),

but not explicitly address,

at least one of (a) a patient identifier, (b) a medical condition identifier, (c) a patient address and (d) patient medical record information.

However, the above limitation is mere data limitations that are only non-functional descriptive materials without functionality involvement in the recited system, i.e. a user who uses the EB can create a database with the information related to a specific business (See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) - Descriptive materials will not distinguish the claimed invention from the prior art in terms of patentability).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include in hierarchy structure of the database generated by Access 2000, the data items that relate to patient information for conforming to his business requirement.

As per Claim 7: Access2000 including its Expression Builder (EB) discloses, ***"wherein said expression processor resolves said resultant expression to provide a result,***

but does not explicitly address, ***comprising a financial reimbursement sum determined by health care policy terms.***

However, the above limitation is mere data limitations, i.e, it includes ***a financial reimbursement sum***, that is pre-empting of a formulary calculations. The whole recitation ***"comprising a financial reimbursement sum determined by health care policy terms"*** of the above limitation describes ***said resultant expression*** to a certain business, but **does not cause any transition or change** when this

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type of resultant expression put in the scope of the claim. Thus, that recitation, ***comprising a financial reimbursement sum determined by health care policy terms***” is only non-functional descriptive, a mathematical preemption (See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) - Descriptive materials will not distinguish the claimed invention from the prior art in terms of patentability).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include in hierarchy structure of the database generated by Access 2000, the data items with a particular calculation for conforming to the business requirement.

As per Claim 16: Access2000 including its Expression Builder (EB) discloses, ***“A system for providing a user interface display image supporting user entry of an expression for use in deriving information associated with a patient, comprising:***

a user interface menu generator for providing a displayable image (i.e. the EB. See USC, p. 20-23: all items 1-48, that tutor a user for using an EB) ***including,***

a first image window listing a plurality of selectable data items (USC, p. 21: in the EB having the

window that shows data items Query1, Constants, Operators, etc) ***individually selectable from a***

plurality of different types of predetermined data items (This window provides a user individually

selects a plurality of different types (i.e. subdirectory of Query1) of predetermined data items (i.e.

Query1)) available ***for incorporation in an expression, said plurality of different types of***

predetermined data items comprise predetermined data items and associated predetermined

allowable values for corresponding predetermined data item (USC, p. 21: The window shown with

“Construct your equation here” that is associated with plurality of different types of predetermined data

items from the first window and associated predetermined allowable values for corresponding

predetermined data item),

an image prompt element permitting user entry of said expression and for incorporating a data item in said expression from said listed data items to provide a resultant expression in

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response to user selection of said data item in said first image window (USC, p. 20-23: all items 1-48, for seeing how such a response from a selection of data items), **and**

an icon for initiating storing of said resultant expression (See the Icon "OK" in the EB); **and**

an expression processor for resolving said resultant expression to provide a result in response to user command (That is the DLLs provided within the Microsoft Windows supporting Access 2000 for running this application),

said plurality of different types of predetermined data items (See USC, p. 21 the field includes data items such Company name, Country, etc) **identified at least one of (a) a patient identifier, (b) a medical condition identifier, (c) a patient address and (d) patient medical record information and.**

said user interface menu generator provides an image window indicating said associated predetermined allowable values for a corresponding predetermined data item comprises at least one of, (i) an acceptable parameter and (ii) an acceptable value, associated with a data item selected by a user via said first image window (that is the EB, where the acceptable parameter and acceptable value are validate via the validation rule, e.g. See UIS, p. 8, the Validation Rule is in the Properties section of the EB),

but not explicitly address

at least one of (a) a patient identifier, (b) a medical condition identifier, (c) a patient address and (d) patient medical record information.

However, the above limitation is mere data limitations that are only non-functional descriptive materials without functionality involvement in the recited system, i.e. a user who uses the EB can create a database with the information related to a specific business (See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) - Descriptive materials will not distinguish the claimed invention from the prior art in terms of patentability).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include in hierarchy structure of the database generated by Access 2000, the data items that relate to patient information for conforming to his business requirement.

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be reached on 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708.

The facsimile number for the organization where this application or proceeding is assigned is the Central Facsimile number **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ted T. Vo
Primary Examiner
Art Unit 2191
July 07, 2006